

# Torys on Intellectual Property

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## Is Get-up Gone in Canada?

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The recent decision of the Federal Court of Canada in *Apotex v. Registrar of Trademarks and Glaxo Group Limited* (March 12, 2010) continues a line of cases that restricts the use of “get-up” (which refers to colour, shape of packaging, etc.) as a trademark in respect of prescription pharmaceutical products.

Glaxo Group Limited had obtained a trademark registration for the dark and light purple colours as applied to certain portions of the visible surface of an inhaler. Apotex and other generic drug manufacturers instituted proceedings to strike out this trademark registration on the ground that it was not distinctive. The evidence showed that Glaxo also owned registrations for the trademarks “Advair” and “Diskus”, which were each used in relation to the same inhaler: when dispensed to the public, the inhaler is packaged in a box labelled with the “Advair” and “Diskus” trademarks, along with dosage and storage details and information about Glaxo.

Justice Barnes rejected Glaxo’s argument that distinctiveness could be established from the fact that physicians, pharmacists and patients drew an association between the appearance of Glaxo’s get-up and Glaxo as the source of the inhaler. Instead, the Court held that the trademark had to trigger a purchasing decision and not merely indicate source: “What is required is that physicians, pharmacists and patients relate the trade-mark to a single source and thereby use the mark to make their prescribing, dispensing and purchasing choices.” While Justice Barnes accepted that there is nothing inherently objectionable about a unique combination of product shape and colour being classified as a trademark, he found that in the realm of prescription medications, the significance of colour and shape to purchasing choices and brand identification is less obvious because of the involvement of physicians and pharmacists in the purchasing decision. Specifically, the Court observed that “in the context of a market where purchasing decisions are usually made by professionals or on the advice of professionals, the commercial distinctiveness of such a mark [a mark based on colour and/or shape] will be inherently more difficult to establish.”

The Court also considered that the prescription product would be sold to consumers with a label affixed; and the Court expressed the presumption that consumers would be heavily reliant upon the printed information in drawing conclusions about source. The Court found that the distinctiveness of a mark based on colour and shape may be diminished by its association with a registered trade name. The Court also noted that no notice was given of the trademark or its ownership on the product packaging or the inhaler itself, perhaps raising the question whether the get-up was viewed by the rights holder as a trademark at all.

On the basis of the foregoing findings, Justice Barnes held that “colour and shape are not the primary characteristics by which Glaxo distinguishes the Advair Diskus inhaler from the wares of its competitors or, more significantly, by which its purchasers make

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their choices.” Finding the trademark to the get-up to lack distinctiveness, he ordered that the registration for the Glaxo trademark be struck from the register.

Although this decision is not the first to blaze a trail on the subject of “size, shape and colour” trademarks in the pharmaceutical field, this decision paves the way for generic drug manufacturers to make look-alike inhalers, which will have the effect of precluding recognition by consumers when the non-branded product is dispensed. Glaxo has appealed to the Federal Court of Appeal.

The decision highlights the challenges facing prescription drug manufacturers – as well as manufacturers in other industries – wishing to use combinations of colour, shape, size and words to indicate product source. The case underscores the importance of reinforcing (i) with consumers, the association between such features and a particular source and (ii) with a court, the association between such features and the purchasing decision. Manufacturers would be well-advised to seek strategic input from their trademark advisers concerning their marketing and branding initiatives, including proposed packaging and labelling, both before and after product launch to maximize the chances that the get-up will be seen to serve as a trademark. **1**